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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,144	02/28/2002	David Engel	87335.3481	5030
30734	7590	04/20/2004	EXAMINER	
BAKER + HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304			SORKIN, DAVID L	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/084,144	ENGEL, DAVID	
Examiner	Art Unit		
David L. Sorkin	1723		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-4,6-13,16-18 and 29-33 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-4,6-13,16-18 and 29-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 April 2004 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is lack of antecedent basis for "said drive system component", recited in each of claims 10, 11 and 12.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2, 7, 29, 30 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al. (US 1,719,935). Regarding claim 29, Jones ('935) discloses

a drive assembly comprising a stationary cover (6); a speed reducer (13,20,17,21,16) disposed within said cover; a first support (9) and a second support (10), wherein said cover is stationary during operation of said speed reducer. Regarding claim 30, the speed reducer is a concentric speed reducer (see Fig. 1). Regarding claim 2, said cover comprised a circular side wall and two opposite ends (see Fig. 1; page 1, lines 80-81). Regarding claim 7, said second support includes a second flange having a diameter less than the diameter of said cover (see Fig. 1). Regarding claim 33, Jones ('935) discloses a drive assembly comprising means (6) for covering; means (13,20,17,21,16) for reducing disposed in said means for covering; first means (9) for supporting; and second means (10) for covering, wherein said means for covering is stationary during operation of said means for reducing.

6. Claims 2, 3, 6-8, 10-13, 16-18 and 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Magnuson (US 3,055,237). Regarding claim 29, Magnuson ('237) discloses a drive assembly comprising a cover (16); a speed reducer disposed within the cover (see col. 3, lines 69,79; Fig. 1); a first support (12 and in the alternative 17) that supports said cover; and a second support (13 and in the alternative 18) that supports said cover. The cover of Magnuson ('237) is stationary relative to other elements such as 17 and 18. The claim fails to require the cover to be stationary relative to any claimed element. Regarding claim 2, said cover comprises a circular side wall with two opposite ends (see Fig. 1, col. 1, lines 67-68). Regarding claim 3, said cover is a hollow cylinder having a constant diameter (see Fig. 1). Regarding claim 6, said first support (12) includes a first flange having a diameter greater than a

diameter of the cover (see Fig. 1). Regarding claims 7 and 8, said second support (13 and the alternative 18) includes a second flange having a diameter less than the diameter of the cover (see Fig. 1). Regarding claim 10, a first sealing element (20) is disposed between the shoulder and the cover (see Fig. 1). Regarding claims 11 and 12, a second sealing element (20) is disposed between the flange and said cover (see Fig. 1). Regarding claim 13, the sealing elements are O-rings (20). Regarding claims 30 and 32, said speed reducer is a concentric speed reducer (see Fig. 1). Regarding claim 31, Magnuson ('237) discloses a drive assembly comprising a cover (16); a speed reducer disposed within the cover (see col. 3, lines 69,79; Fig. 1); a first seal (20, the one adjacent 12) that supports said cover; and a second seal (20, the one adjacent 13) that supports said cover. Regarding claim 16, the sealing elements are O-rings (20). Regarding claim 17, said cover comprises a circular side wall with two opposite ends (see Fig. 1, col. 1, lines 67-68). Regarding claim 18, said cover is a hollow cylinder having a constant diameter (see Fig. 1). Regarding claim 33, Magnuson ('237) discloses a drive assembly comprising means (16) for covering; means for reducing speed disposed within the covering means (see col. 3, lines 69,79; Fig. 1); first means (12 and in the alternative 17) for supporting; and a second means (13 and in the alternative 18) for supporting. The cover of Magnuson ('237) is stationary relative to other elements such as 17 and 18. The claim fails to require the cover to be stationary relative to any claimed element.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones ('935) in view of Kesig et al. (US 5,735,603). The assembly of Jones ('935) was discussed above. Jones ('935) fails to disclose stainless steel as required by claim 4 and also fails to disclose the six-inch dimension of claim 4. See *In re Leshin* (125 USPQ 416 (CCPA 1960) regarding the obviousness of making parts of well known materials and *In re Rose* 105 USPQ 237 (CCPA 1955) and *Garder v. TEC Systems, Inc.* 220 USPQ 777 (Fed. Cir. 1984) regarding the obviousness of selecting a size. Kesig ('603) teaches that making housing components of stainless steel provides the benefit of corrosion resistance (see col. 14, lines 35-40). It is considered that it would have been obvious to one of ordinary skill in the art to have made part of the assembly of Jones ('935) stainless steel to obtain the corrosion resistance advantage of stainless steel as taught by Kesig ('603) (see col. 14, lines 35-40).

9. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magnuson (US 3,055,237) in view of Kesig et al. (US 5,735,603). The assembly of Magnuson ('237) was discussed above. Magnuson ('237) fails to disclose stainless steel as required by claims 4 and 9 and also fails to disclose the six-inch dimension of claim 4. See *In re Leshin* (125 USPQ 416 (CCPA 1960) regarding the obviousness of

making parts of well known materials and *In re Rose* 105 USPQ 237 (CCPA 1955) and *Garder v. TEC Systems, Inc.* 220 USPQ 777 (Fed. Cir. 1984) regarding the obviousness of selecting a size. Kesig ('603) teaches that making housing components of stainless steel provides the benefit of corrosion resistance (see col. 14, lines 35-40). It is considered that it would have been obvious to one of ordinary skill in the art to have made part of the assembly of Magnuson ('237) stainless steel to obtain the corrosion resistance advantage of stainless steel as taught by Kesig ('603) (see col. 14, lines 35-40).

#### ***Response to Arguments***

10. The examiner agrees with applicant's statement that the cover of Magnuson ('237) is disclosed to rotate relative to standards 10 and 11 during a disclosed operation. However, the pending apparatus claims do not require the cover to be stationary relative to any particular claimed element or elements. The cover of Magnuson ('237) is stationary relative to, for example parts 17 and 18. As currently recited, the "stationary" aspects of the pending claims relate only to the manner in which the claimed device is intended to operate. However, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L. Sorkin  
Examiner  
Art Unit 1723

  
David Sorkin